

### **REMARKS**

This responds to the Office Action dated May 9, 2007.

Claims 18 and 21 are amended, Claims 16-22 are pending in this application.

#### **Objection to the Claims**

Claim 21 was objected to under 37 C.F.R. 1.75 as being a substantial duplicate of claim 17. Applicant has amended claim 21 to overcome the objection.

#### **§102 Rejection of the Claims**

Claims 16, 17 and 19-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Sherman (U.S. Patent No. 6,059,778).

Applicant traverses. Applicant believes that claim 16 is not anticipated or obvious in view of the cited reference since the reference does not include or suggest each limitation recited in the claim. For instance, Applicant cannot find in the cited reference: a tip electrode having a thermal time constant of approximately 240 ms; and a power control system configured to provide power to the tip electrode; and wherein the power control system delivers an energy pulse of between approximately 0.01 ms to 4 ms via the tip electrode, and the on portions and off portions of the duty cycle have a ratio of between 50% - 100%, as recited in claim 16. In contrast, the cited reference discusses controlling the duty cycle of energy delivered via ring electrodes 32. There is no discussion of any details of tip electrode 36. The Office Action asserts that such subject matter is inherent in the cited reference. However, the cited reference includes no discussion of such a capability.

Applicant believes the Office Action has not established a *prima facie* case of inherency because, as recited in MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Here, the Office Action only argued that Sherman is “inherently capable of this intended use.” (Page 3 of Office

Action). Thus, the Office Action does not even assert that the allegedly inherent characteristic is necessary, let alone provide a basis in fact and/or technical reasoning.

In the Response to Arguments section of the Office Action, the Office Action states that Sherman “clearly discloses a tip electrode in conjunction with a power control system (Fig. 1).” However, the Sherman reference does not show or discuss that tip electrode 36 is connected to the power control system in any of the examples or figures of the reference. Thus, it is not inherent.

Moreover, the Office Action cites that col. 7, lines 44-52 of the cited reference disclose a duty cycle having a ratio of between 50%-100%. Applicant traverses. That portion of the reference only mentions a 50% duty cycle and a 10% duty cycle.

Claims 17 and 19-22 include each limitation of their parent claim and are therefore also not anticipated or obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

### §103 Rejection of the Claims

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. Patent No. 6,059,778). Claim 18 includes each limitation of its parent claim and is not obvious over the cited reference for the reasons given above. Reconsideration and allowance are respectfully requested.

Claims 16-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. Patent No. 6,059,778) in view of Sherman (U.S. Patent No. 5,971,980).

Applicant traverses. Applicant believes claims 16-22 are not obvious over the cited references for the reasons given above. Here, the secondary reference also does not include or suggest: a tip electrode having a thermal time constant of approximately 240 ms; and a power control system configured to provide power to the tip electrode, the power having a plurality of alternating on portions and off portions, one set of adjacent on and off portions defining a duty cycle; wherein the power control system delivers an energy pulse of between approximately 0.01 ms to 4 ms via the tip electrode, and the on portions and off portions of the duty cycle have a

ratio of between 50% - 100%, as recited in claim 16. Reconsideration and allowance is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

11/8/07

By

  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8 day of November 2007.

Name

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Signature

